



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,664	06/27/2003	Mark R. Albrecht	171006-0001U1	7078
24267 7590 10/31/2008 CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210				
EXAMINER ALMATRAHI, FARIS S				
ART UNIT		PAPER NUMBER		
3627				
MAIL DATE		DELIVERY MODE		
10/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,664

Applicant(s)

ALBRECHT, MARK R.

Examiner

FARIS ALMATRAHI

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
4a) Of the above claim(s) 2-56 and 58-66 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 57 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 01/12/2006, 11/16/2006
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of the Application

1. **Claims 1-66** are pending in this application.
2. **Claims 2-56 and 58-66** are withdrawn.
3. If applicant is aware of any prior art or any co-pending application not already on record, the applicant is reminded of his/her duty under 37 C.F.R §1.56 to disclose the same.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1 and 57** are rejected under 35 U.S.C 103(a) as being unpatentable over Baker (US Pat No. 6,473,741) in view of Dang et al. (US Publication No. 2003/0101111).
6. Regarding Claims 1 and 57, Baker discloses a financial service method comprising:

- For plural respective direct service providers, loading, onto a remotely accessible part of a common host server located in the United States, ultimate client specific

financial files and corresponding reference materials, the host server providing access to a remote computer client of information concerning the ultimate client specific files and corresponding reference materials (Column 10 line 56 – Column 11 line 20).

- Retaining outsourced personnel to perform financial service projects for ultimate clients of the financial services firms, the outsourced personnel performing the financial service projects while located outside the United States (Column 3 lines 1-46).
- Monitoring and reporting the status of the financial service project (Column 12, lines 41-67).

7. Baker fails to explicitly disclose a financial services outsourcing method comprising providing the outsourced personnel limited access to the server; the outsourced personnel performing the financial service project through a remote limited access client located outside the United States connected to the host server.

8. However, Dang suggests a financial services outsourcing method comprising providing the outsourced personnel limited access to the server (Figure 6, Paragraph [0011]); the outsourced personnel performing the financial service project through a remote limited access client located outside the United States connected to the host server (Paragraph [0015]).

9. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Dang in the device of Baker reference to include a financial services outsourcing method comprising providing the

outsourced personnel limited access to the server; the outsourced personnel performing the financial service project through a remote limited access client located outside the United States connected to the host server, for the advantage of reducing internal information technology expenses of merchants by eliminating the need for an in-house internally developed financial service system (Dang, Paragraph [0036]).

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1 and 57 provisionally rejected on the ground of nonstatutory double patenting over claim 1 of copending Application No. 10/608,651 and over claim 1 of copending Application 10/609,033. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Instant Application: 10/609,033	Copending Application: 10/608,651	Copending Application: 10/608,664
Claim 1: A financial services outsourcing method for facilitating outsourcing of tax return preparation services for numerous clients on behalf of plural direct service providers serving the numerous clients, the financial services being outsourced to a given outsourcing group, the clients comprising a first set of clients in a first country, having tax return filing obligations for the first country, and comprising a second set of clients in a second country having tax return filing obligations for the second country, the method comprising: for plural respective direct service providers, loading, onto a remotely accessible part of a common host server, client specific financial files and corresponding reference materials, the host server providing access to a remote computer client of information concerning the ultimate client specific financial files and corresponding reference materials; retaining outsourced personnel to perform tax returns for the clients of the direct service providers, the outsourced personnel preparing the tax returns while located outside the first and second countries; providing the outsourced personnel limited access to the server; the outsourced personnel preparing the tax returns through a remote limited access client located outside the first and second countries connected to the host server; and monitoring and reporting the status of the financial service project.	Claim 1: A financial services outsourcing method for facilitating a direct service provider's management of human resources for providing financial services to numerous clients, the financial services being outsourced to an outsourcing group abroad, the method comprising: for plural respective direct service providers, loading, onto a remotely accessible part of a common host server located in a given country, client specific financial files and corresponding reference materials, the host server providing access to a remote computer client of information concerning the ultimate client specific financial files and corresponding reference materials; retaining outsourced personnel to perform tax return preparation services for clients of the direct service providers during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year, the outsourced personnel preparing the tax returns and performing the other financial service projects while in an outsource country different from the given country; providing the outsourced personnel limited access to the server; the outsourced personnel performing the financial service project through a remote limited access client located in the outsource country; and monitoring and reporting the status of the tax return preparation and of the other financial service projects.	Claim 1: A financial services outsourcing method for facilitating a direct service provider's outsourcing of financial services for numerous ultimate clients, the financial services being outsourced to an outsourcing group abroad, the method comprising: For plural respective direct service providers, loading, onto a remotely accessible part of a common host server located in the United States, ultimate client specific financial files and corresponding reference materials, the host server providing access to a remote computer client of information concerning the ultimate client specific financial files and corresponding reference materials; retaining outsourced personnel to perform financial service projects for ultimate clients of the financial services firms, the outsourced personnel performing the financial service projects while located outside the United States; providing the outsourced personnel limited access to the server; the outsourced personnel performing the financial service project through a remote limited access client located outside the United States connected to the host server; and monitoring and reporting the status of the financial service project.

Claim 1 of the instant application discloses a financial services outsourcing method for facilitating outsourcing of financial services. The copending applications both disclose a financial services outsourcing method that reads on the instant application. It is obvious that tax preparation services are financial services.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faris Almatrahi whose telephone number is (571) 270-3326. The examiner can normally be reached on Monday to Friday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Faris Almatrahi/

Examiner, Art Unit 3627

FA

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627